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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/734,443	10/17/96	KEYT	A-63896/WHD

HM12/0515

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EXAMINER
SADUD, C

ART UNIT	PAPER NUMBER
1646	23

DATE MAILED: 05/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/734,443

Applicant(s)

KEYT et al.

Examiner

Christine Saoud

Group Art Unit

1646



☒ Responsive to communication(s) filed on Jan 5, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1646

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 05 January 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/734,443 is acceptable and a CPA has been established. An action on the CPA follows.

Response to Amendment

2. Claim 1 has been amended as requested in the amendment of paper #22, filed 05 January 2000. Claim 15 was canceled in the amendment of paper #15, filed 04 October 1999. Claims 1-14 are pending in the instant application.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

5. Applicant's arguments filed 05 January 2000 have been fully considered but they are not deemed to be persuasive.

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Claim Rejections - 35 USC § 102

6. Claims 1-2, 10-13 and 14 stand rejected under 35 U.S.C. 102(b) as being anticipated by Claffey et al. (Biochim. Biophys. Acta. 1246(1): 1-9, 1995) for the reasons of record in paper #5.

7. Claims 1-3, 10-12, and 14 stand rejected under 35 U.S.C. 102(b) as being anticipated by Potgens et al. (J. Biol. Chem. 269(52): 32879-32885, 1994) for the reasons of record in paper #5.

Claim Rejections - 35 USC § 103

8. Claims 4-6 and 9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Potgens et al. as applied to claims 1-3, 10-12, and 14 for the reasons of record in paper #5.

9. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potgens et al. as applied to claims 1-3, 10-12, and 14 in view of Pang (U.S. Pat. No. 5,418,135) for the reasons of record in paper #5.

10. Claim 13 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Potgens et al. as applied to claims 1-3, 10-12, and 14 for the reasons of record in paper #5.

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Applicant states that the claims have been amended to include the limitation that the biological activity inhibited was induction of a VEGF response. Applicant also states that the Examiner indicated that this amendment would overcome the prior art. However, upon reconsideration of the prior art, the rejections are maintained for the reasons of record and for the reasons provided below.

Potgens et al. made VEGF mutants in which the 2nd, 3rd, 4th, and 5th cysteine residues in the protein were substituted with serine, which correspond to amino acid positions 51, 57, 60 and 61 of human VEGF. C2S and C4S of Potgens et al. are structurally the same proteins as what is being claimed in claim 3 and claim 8. Applicant's arguments that their mutants possess some biological activity which is not possessed by the protein mutants of the prior art defies the laws of nature. It is inconceivable that two proteins with the same amino acid structure would not possess the same biological activity. If Applicant's mutants differ from the prior art proteins, then the claims should reflect those features which distinguish the claimed invention from that of the prior art. The recitation of a biological function is not sufficient, because this biological function would inherently be possessed by the prior art proteins because they have the same structure. It is noted that claims 4-6 are directed to substitution with aspartic acid. If Applicant has evidence that this substitution provides some biological activity which is not provided by the serine substitutions of the prior art, this may serve as a basis of patentability over the prior art proteins. However, the claims would need to be limited to substitution with aspartic acid.

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Conclusion

11. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Saoud, Ph.D., whose telephone number is (703) 305-7519. The examiner can normally be reached on Monday to Friday from 7AM to 3PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556. If this number is out of service, please call the Group receptionist for an alternate number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

May 12, 2000

**CHRISTINE SAOUD
PATENT EXAMINER**

Christine Saoud